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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,664

08/29/2003

R. Magdina

7782

7590 10/01/2008  
Ely Zborovsky Patent Bureau  
6 Schoolhouse Way  
Dix Hills, NY 11746

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/650,664

**Applicant(s)**

MAGDINA ET AL.

**Examiner**

Kriellion A. Sanders

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12, 16, 24-27 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 24-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-3 of U.S. Patent No. 6,686,403. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims directly correspond in limitations to the weight percentages of 4.5% melamine polyphosphate, 5.25% melamine and 5.25% pentaerythritol, within the paint composition and would necessarily require a ratio of these components of 30%, 30% and 35%, respectively.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1796

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-12, 16, 24-27 and 29-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wainwright et al, US Patent No. 5,532,292 Wainwright et al,

The rejection is repeated for reasons of record. Wainwright et al discloses an intumescent composition useful for formulating paints. The compositions are said to possess enhanced fire retardancy and comprise fire retardant components such as exemplified in the working examples. These components may be incorporated into a paint binder composition and may be present in the intumescent powder blend composition in parts by weight as follows:

COMPONENT	
Ammonium polyphosphate	10-55pbw
Melamine	5-40pbw
Pentaerythritol	4-35pbw
Pigment	0-40pbw
Superwool Grade X-607	5-30pbw
Ceepree	0-30pbw
Zinc Borate	0-10pbw

The above intumescent blend is then incorporated into a binder composition. Wainwright et al the sets forth a typical binder composition for paints as follows:

COMPONENT	Range of Amounts (for preferred composition)	
	WET	DRY
Intumescent Blend Such as Blend K or Blend Z or A/S	35-75 (55)	50-88 (75)
Non-active solids (binder)	10-35 (18)	12-50 (25)
Volatile solvent (water)	15-40	0-5*
styrene, xylene, acetone, etc.)	(27)	(0)

\*Small amounts of solvent may be present if not properly dried.

When the intumescent blend is 35% of the total binder composition which constitutes a total of 100%pbw, then the lower loading of individual intumescent components are present in the following amounts:

Ammonium polyphosphate is 10% of the intumescent blend and 3.5% of the total binder composition or paint

Melamine is 5% of the intumescent blend and 1.75% of the total binder composition or paint

Pentaerythritol is 4% of the intumescent blend and 1.40% of the total binder composition or paint

In the working example of Wainwright et al the ammonium polyphosphate is present in an amount less than 15% by weight. When used at the lower loading limits the combination of ammonium polyphosphate, melamine and pentaerythritol is less than 15% by weight of the total coating or paint formulation. It is clear that Wainwright suggests using these components in amounts that directly correspond to the amounts of applicant's claims.

It would have been obvious to one of ordinary skill in the art, if not fully anticipatory, to utilize the intumescent or flame retarding components of Wainwright et al at amounts that total 15% by weight of the total paint composition absent a clear showing of unexpected results attributable to such a variation. See the abstract and col. 4, line 10 through col. 5, line 57.

#### ***Response to Arguments***

2. Applicant's arguments filed 6/12/2008 have been fully considered but they are not persuasive. Applicant states that, "it is believed to be clear that the reference does not disclose any hint or suggestion to make the invention obvious. In order to arrive at the present invention from the teaching of the reference, the reference has to be fundamentally modified, and in particular, by including into it the new features of the present invention which are now defined in claims 1, 9 and 24, by converting the intumescent composition disclosed in the patent to Wainwright into the paint of the present invention. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification."

3. This argument has not been found to be persuasive because Wainwright discloses all element of applicant's claimed composition wherein the patented compositions are in the form of coatings that are then utilized to form intumescent compositions. Even the intumescent coatings of patentees' compositions comprise pigments. The formulation of a paint from the coating compositions of Wainwright would have been obvious to one of ordinary skill in the art at the time of applicant's invention.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kriellion A. Sanders/

Primary Examiner, Art Unit 1796

Kriellion A. Sanders  
Primary Examiner  
Art Unit 1796